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Attorney Ref. No. 659-1143
Client Ref. No. 19,226

REMARKS

In the Office Action mailed June 8, 2006, the Examiner rejected claims 1, 2, 7-9, 11-13, 15, 16 and 28 under 35 USC 102(b) as being anticipated by US Pub. No. 2002/0151863 A1 to Ostubo. The Examiner also rejected claims 3-6, 10, 14 and 29-31 under 35 USC 103 as being obvious over Ostubo in view of USP 6,264,641 to Van Gompel alone, or further in view of USP 5,062,840 to Holt. Applicants respectfully disagree and submit that the claims as presented herein are patentable over the cited references.

Claims 1, 2, 4-9, 11-16, 28 and 29:

Applicants have amended independent claims 1 and 28 to recite “forming a cutout in said web and thereby *removing a portion of said body panel material from said web*, . . . wherein said removed portion of said body panel material *does not form any part of said front and rear body panel webs*. ” Support for these amendments is found throughout the specification and drawings (see, e.g., Specification at p. 8, lines 16-17; at p. 28, line 18 to p. 29, line 26).

In contrast, Ostubo discloses making a single longitudinal cut to form the first and second half webs 81, 82, *without any material being removed* (Ostubo at para. 28; FIGS. 6 and 9). The cut edges form curved convex edges (Ostubo at paras. 7 and 24, FIG. 5). After the webs 81, 82 are separated, a pad 4 is connected, such that the tops 42 of leg holes 41 substantially coincide with the respective tops 44 of the thighs 45 b of a baby 43 (Ostubo at para. 24; FIG. 5). In this way, Ostubo emphasizes that the mating convex curves of the front and rear body panels 2, 3 provide a purported optimal fit of the diaper (Ostubo at para. 7).

As such, even if the Examiner considers the trough (edge adjacent elastic 77) of web 81 to be a “cutout,” the material removed forms the crest (edge adjacent

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elastic 78) of web 82 and thereby forms part of the body panel webs (see, e.g., FIG. 6 (the same goes for trough 79 of web 82 and crest 76 of web 81)). Accordingly, claims 1 and 28, and claims 2, 4-9, 11-16 and 29 depending therefrom, should be passed to allowance.

Claims 10, 14,¹ 29 and 31:

Claim 10 has been rewritten in independent form. Claim 10 recites “forming a cutout in said web while said web is in said stretched condition.” Claims 29 and 31 have similar recitations.

In the Office Action, the Examiner acknowledges that Ostubo “does not expressly teach stretching the web in the longitudinal direction prior to forming the cutout in the web” (Office Action at 7), but then asserts that “stretching a web in various directions prior to cutting is well known in the art of absorbent articles” (Office Action at 7, citing to Van Gompel). Nowhere in the passages of Van Gompel cited by the Examiner, however, does Van Gompel disclose “forming a cutout in said web while said web is in a stretched condition.” Rather, the cited passages merely refer to (1) an outer cover made of a necked material (Col. 7, line 62 to Col. 8, line 33), and (2) a body panel made of an elastomeric material (Col. 21, line 62 to Col. 22, line 19). While such materials may (or may not) be stretched, nowhere in those passages does Van Gompel refer to stretching the web *prior to forming a cut* or forming the cut while the web is in a *stretched condition*. Just because a material is capable of being stretched, does not disclose or suggest that it is stretched prior to cutting such a material, let alone prior to forming a

¹ Applicants have amended claims 14 and 15 to recite “front and rear body panel webs,” which has proper antecedent basis. These amendments merely clarify claims 14 and 15, and have not narrowed in any way the scope thereof.

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cutout in the material. Accordingly, since the references, even if combined as suggested by the Examiner, fail to disclose or suggest all of the limitations of the recited claims, the Examiner has failed to make out a *prima facie* case of obviousness (MPEP 2143.03).

For the same reasons, Van Gompel also does not disclose or suggest “stretching at least one of the front and rear body panel webs to a stretched condition prior to said connecting said crotch member thereto and connecting said crotch member to said at least one of said front and rear body panel webs when in said stretched condition” as recited in claim 14. Accordingly, claim 14 also should be passed to allowance on the next Office Action.

Claim 30:

Claim 30 recites cutting a web such that “a portion of said cutout is formed in each of said front and rear body panel webs, wherein said portions of said cutout formed in each of said front and rear body panel webs are aligned in a lateral cross direction.” As acknowledged by the Examiner, “Ostubo ’864 does not teach a portion of a cutout being located in each of the front and rear body panel webs” (Office Action at 6, para. 19, 20). Instead, the Examiner asserts that “Van Gompel ’641 teaches a portion of a cutout being located in each of the front and rear body panel webs,” and that it “would have been obvious to one of ordinary skill in the art to modify Ostubo ’864 to include a portion of the cutout being formed in each of the front and rear body panel webs” (*Id.*). Applicants respectfully disagree.

To establish a *prima facie* case of obviousness, the Examiner must establish that there is some motivation to combine the references (MPEP 2143). In this case, both references (Ostubo and Van Gompel) teach against any such combination. In

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particular, as noted above, the entire premise of Ostubo is to provide elastics 23, 24 and body panels 2, 3 that define a leg hole 41 that coincides with the tops 44 of the user's thighs (Ostubo at para. 24; FIG. 5; para. 6). As such, the front body panel 2 necessarily has a leg hole having a contiguous convex curved edge as shown in FIG. 5 (*id.*; see also para. 7). Accordingly, there is no motivation to incorporate the body panels of Van Gompel into Ostubo, since that construction would result in the front portion of the leg hole curving *convex downwardly*, rather than *upwardly* (see Ostubo at para. 7).

It is important to remember, in this respect, that the Examiner must look at the references as a whole, i.e., the overall body panel construction of Ostubo and Van Gompel, rather than just at individual parts, i.e., the "cutouts" of Van Gompel. Indeed, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so" (MPEP 2143.01). Moreover, "a statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (MPEP 2143.01). As in the present case, where the proposed modification to Ostubo renders it unsatisfactory for its intended purpose,

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there can be no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In addition, Van Gompel discloses that the absorbent composite 32 is secured to a *garment side surface* of the body panels 52, 53 (Van Gompel at Col. 16, lines 12-40; FIGS. 3 and 3D)). In this way, the curved edges 64, 65 of the body panels provide greater access to the absorbent composite for absorbing exudates and other bodily fluids (Van Gompel at FIG. 3). In contrast, the pad of Ostubo is secured to the *bodyside* surface of the front and rear body panels 2, 3 (Ostubo at para. 21, FIG. 1). As such, there is no need for a cutout in the either panel of Ostubo to provide access to the pad 4. For this additional reason, there is no suggestion to form a cutout in the rear panel in Ostubo. In this respect it is important to remember that it is *not necessary whether the claims recite such attachment configurations*, but rather simply whether there is a lack of motivation to combine the references based on their teachings.

In this same vein, Ostubo discloses the importance of continuously applying elastic members 73 and 74 so as to draw substantially sinusoidal curves, with the members 73 and 74 being “symmetric about a center line c of the web” (Ostubo at para. 27; FIG. 6). In this way, the web may be cut into first and second half webs 81, 82 along line d, with one elastic member 72 associated with one leg-hole, and the other leg elastic member 73 associated with the other leg-hole (Ostubo at para. 28, FIG. 6). As such, Ostubo teaches against forming the profiles of Van Gompel, which would interrupt the sinusoidal curvature of the elastic members, and prohibit the ability to cut the web between the elastic members so as to form the desired profiles that conform to the thigh of the user (Ostubo at paras. 24-28; FIG. 6).

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As set forth in MPEP 2143.01, since “the proposed modification or combination of [Ostubo and Van Gompel] would change the principle of operation of the [Ostubo] invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *Citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (. . . “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.”).

In summary, there simply is no suggestion to combine Van Gompel and Ostubo as suggested by the Examiner, regardless of whether those references may or may not teach all of the limitations of the claims. Indeed, as explained herein, those references teach against such a combination. Accordingly, Applicants respectfully request that the rejection of claim 30 be withdrawn, and notice to that effect is earnestly solicited.

New Claims 32 and 33:

New claims 32 recites that “said cutting said web of body panel material is performed *separately from and after* said forming said cutout in said web,” and new claim 33 recites that “said cutting said web of body panel material is performed *separately from and before* said forming said cutout in said web.” Support for these claims is found throughout the specification and drawings, including for example and without limitation at page 29, lines 4-17. None of the cited references discloses cutting a web in a longitudinal direction separately from, and/or before/after, forming a cutout. Rather, Ostubo, for example, discloses a single cutting operation in the longitudinal direction *without a separate cutout forming step* (Ostubo at para.

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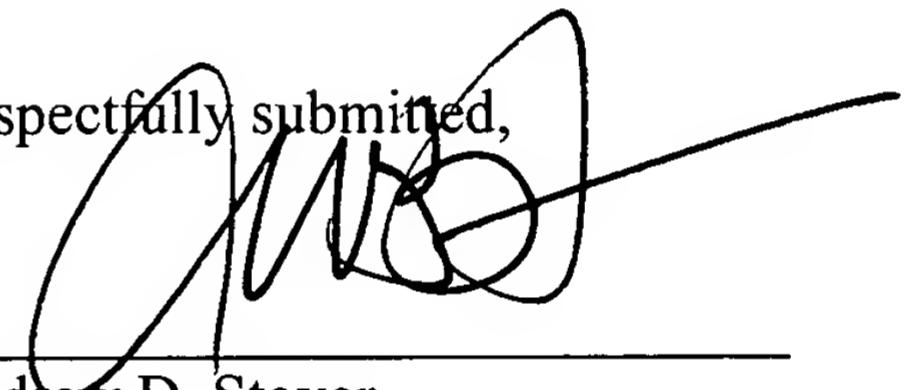
28; FIG. 6). Accordingly, claims 32 and 33 are allowable for this additional reason.

Conclusion

This amendment does not necessitate any change in inventorship. After amendment, this application has 20 claims, including three independent claims. Accordingly, no additional fees are believed to be due. Any questions concerning this amendment or election should be directed to the undersigned attorney at (312) 321-4713.

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Respectfully submitted,


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